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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,666	02/11/2004	Tushar Patel	101896-0233	3475

21125 7590 01/08/2007  
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EXAMINER
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PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/776,666

Applicant(s)

PATEL ET AL.

Examiner

Brian E. Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-29,31-44,46-54 and 86-93 is/are pending in the application.
- 4a) Of the above claim(s) 25,29,32,39-44,47 and 49-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,11-23,26-28,31,33,36-38,46,48 and 91-93 is/are rejected.
- 7) ☒ Claim(s) 8-10,24,34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's AF submission filed on 9/1/06 has been entered.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3,14,17,18,26,27 are rejected under 35 U.S.C. 102(b) as being anticipated by Asher et al. (4773402). Fig. 1 shows an elongate support member with first and second arms **28,29** coupled to the support. Fig. 4 shows the elongate support member **58** being curved. The arms are fully capable of sliding along arcuate portions **55,56** of the elongate member. Each of the arms has a guide member **36,37** respectively mated at a distal end of the arms. Each guide member has at least two pathways (**40,41** and **44,45**) respectively that is fully capable of being aligned with a bore of an implant. It can be construed that the arms are mated to proximal portions **30,31** of the guide members.

Claims 26,28,31,33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kluger (4733657). Fig. 1 shows an adjustable guide member having a first member with an elongate support **4** and a first arm **11** mated to one end and extends transverse to the support member and includes a guide member **9** at a distal end of the arm. It can also be seen there is a second arm **5** with a first end adapted to slidably mate with the elongate support member and has an adjustment mechanism **6** to allow sliding movement along the support member. The second arm also has a second guide member at its distal end. It can also be seen the distal portion of the arms extend at an angle with respect to the proximal portion. The guide members have a hollow pathway forming a barrel extending transverse to arms capable of receiving a tool. Each guide member has proximal and distal portions with opposed first **8** and second **13** pathways respectively to receive a pin. Since the pin is cylindrical the sidewalls of the pathways have two semi-cylindrical sidewalls.

Claims 1-7,11-13,15-23,26,28,31,36-38,48,86-93 are rejected under 35 U.S.C. 102(b) as being anticipated by Coates et al. (5423826). Coates discloses (Fig. 17) a guide device for use with a spinal fixation plate with the device having two movable arms **151,152** and first and second guide members **157** coupled at the distal end of the arms. It can be seen there are cutout portions between notches **161** or tabs or C-shaped hooks in the guide member to receive the plate and oppose each other. Fig. 16 shows the guide member **157** includes first and second pathways **158**. It can be construed that rod **155** is an elongate support member and extends transverse to the arms. Additionally, the arms have a distal portion that is at an angle to the proximal

portion (Figure 20). Each guide member (157) comprises a housing with opposed first and second pathways (Figure 16) where the housing or guide member contains a lumen sleeve (180) which has a rounded tip extends through the barrel into the rounded recess of the accompanying plate. Each pathway in the guide is in communication with each other via a cut out at a distal portion formed in the housing between the first and second pathways (Figure 16) where the cut out portion extends from the housing where the pathways (158) are in communication through the body of the guide. The support member (155) has adjustment knob (154), which allows either arm to move along the adjustment threads of the lockable support member (column 13 lines 50-67). The examiner is interpreting the claimed elements "slidable" in this way: movement of elements along a surface. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. Thus, since the threaded elements move along each other's surface, they must be slidably movable.

### ***Response to Arguments***

Applicant's arguments filed 9/1/06 have been fully considered but they are not persuasive. Applicant argues with respect to the Asher patent that the reference does not teach first and second guide members. After further review the Examiner is interpreting the elements 36,37 as guide members which have first and second pathways as mentioned above. Regarding the comments with respect to the rejection over the Kluger patent, the Applicant argues that the holes or pathways formed by the

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Kluger elements form one continuous opening. In response to applicant's argument that Kluger fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., bores that are not aligned) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It should be noted that two separate bores could be in a bone plate that has a "U" shape such that the bores align with one another. Regarding the Coates rejection, the Applicant argues that the arms of Coates' device are not slidably movable. The Examiner is entitled to give terms in a claim its plain meaning as interpreted by one of ordinary skill in the art. It is noted that the specification must clearly set forth the definition explicitly and with reasonable clarity, deliberateness, and precision. Exemplification is not an explicit definition. Even explicit definitions can be subject to varying interpretations. See *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001) and MPEP 2111.01. The Examiner is interpreting the threadable engagement between the lock rod and the arms in Coates device to be a slidable engagement since the threads of one component slide against the threads of another component.


***Allowable Subject Matter***

Claims 8-10,24,34,35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Thursday from 7:30am to 5pm. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

  
**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**